

Appln. No. 09/763,293
Amd. dated April 14, 2004
Reply to Office Action of October 14, 2003

REMARKS

The Office Action and the Advisory Action dated March 26, 2004, have been carefully reviewed. No claim is allowed, although the examiner has indicated on page 5 of the Office Action that claims 7-8 and 19-21 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. §112, first and second paragraphs. Claims 4-10, 14, 18-21, and 25-27 presently appear in this application and define patentable subject matter warranting their allowance.

Reconsideration and allowance are hereby respectfully solicited.

The telephone conference among the undersigned and Examiners Hamud and Mertz is acknowledged. During this telephone conference, it was discussed that applicants would amend the claims to overcome the outstanding 35 U.S.C. §112, first and second paragraph rejections. The examiners indicated that the non-elected species, pep1 and pep3 and derivatives thereof, will be rejoined, provided that they are also free of the prior art. The examiners also indicated that method claims 11 and 12 should be restricted from this application. Accordingly, in deference to the examiners, claims 11 and 12 are cancelled without prejudice to the filing of a divisional application thereon.

Regarding the examiner's remarks in the Advisory Action, claim 4, as now amended, recites "a synthetic anti-inflammatory peptide of IL-2 or and anti-inflammatory derivative thereof" in the alternative. Accordingly, it is clear that the Markush group recited in claim 4 encompasses both synthetic anti-inflammatory peptides of IL-

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2 and anti-inflammatory derivatives thereof instead of being exclusively limited to only one of the two.

Claims 3-4, 11, 12, 14 and 18-21 have been rejected under 35 U.S.C. §112, first paragraph, for reasons of record set forth in the Office Action mailed January 14, 2003, Paper No. 13. The examiner states that the instant specification is enabling for a synthetic peptide pep2 (SEQ ID NO:1) having the specific modifications recited in claims 7 and 8, and displaying the activities recited in claim 3, but does not enable "all" possible IL-2 derived synthetic peptides having the activities recited in claim 3. The examiner asserts that since instant claims 3, 14, and 18 are drawn to "all" possible IL-2 derived peptides, these claims are not commensurate in scope with what is enable.

This rejection is obviated by the cancellation of claims 3 and 11 without prejudice and the amendment of claims 14 and 18 to change their dependency from claim 3 to newly amended claim 4, which incorporates the activities previously recited in claim 3. For the same reasons that the synthetic peptide pep2 (SEQ ID NO:1), having the specific modifications recited in claims 7 and 8 and displaying the activities recited in amended claim 4 (and as argued on pages 12-13 of the amendment filed July 14, 2003), are considered to be enabled by the examiner, the synthetic peptides pep1 and pep3, having the specific modifications recited in claims 5, 6, 9, and 10, are also enabled. As is the case with pep2, a representative number of specific

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modifications to pep1 and pep3 are disclosed in the specification and the anti-inflammatory activity of the various peptides as shown in Example 8, Table 1 on pages 28-31 of the specification are also disclosed.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 4 and 7-8 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

The examiner has indicated that the recitation of non-elected peptides in claim 4 renders the claim indefinite. However, this issue is moot because in the telephonic interview with Examiners Hamud and Mertz, the examiners indicated that the non-elected species will be rejoined so long as they are free of the prior art.

Claim 4 (vi) is held to be vague and indefinite for the recitation of "chemical derivative". This recitation is amended to positively recite that "additional chemical moieties not normally part of the peptides are present" as supported in the specification in the paragraph bridging pages 11 and 12. Numerous examples of such derivatives are provided in the same paragraph. Accordingly, it is believed that this issue is obviated by the amendment to claim 4 (vi) and the disclosure in the specification.

Regarding claim 4 (ix), the claim is amended to recite, "consisting of a plurality of the same or different peptides (i) to

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(viii)". Accordingly, it is clear that there are no peptides other than the peptides recited in sub-parts (i)-(viii) that are part of the multimer. On the matter of the issue that the claim does not set the number of different or same peptides that make up the claimed multimer, applicants are using the wording "a plurality" instead of "a number". This wording has been accepted in many issued U.S. patents to describe an unspecified amount of monomers that make up a multimer.

The phrases "preferably" and "such as" are now deleted from claim 7. New dependent claim 25 is added to recite the specific preferred embodiments now deleted from claim 7. Likewise, the "preferably" and "such as" language is also deleted from claims 5 (pep1) and 9 (pep 3) with new claims 26 and 27 being added to incorporate the specific preferred embodiments now deleted from claims 5 and 9, respectively.

Claim 7(e) is amended to delete the recitation of "the important".

Reconsideration and withdrawal of the rejection are therefore respectively requested.

In the event that there are still outstanding issues despite the present amendments to the claims, the examiner is encouraged and requested to contact the undersigned by telephone to expedite the resolution of any outstanding issue so that this application may be placed in condition for allowance.

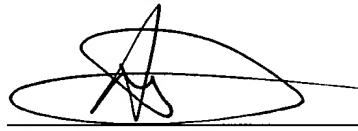
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In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting their allowance. Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,

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